



UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

VENABLE LLP
P.O. BOX 34385
WASHINGTON, D.C. 20043

Paper No.
COPY MAILED

OCT 02 2006

OFFICE OF PETITIONS

In re Patent No. 7,023,805 : DECISION ON REQUEST
Katsutoshi TAJIRI et al. : FOR RECONSIDERATION OF
Application No. 09/939,730 : PATENT TERM ADJUSTMENT
Filed: August 28, 2001 : and
Atty Docket No. 31762-174923 : NOTICE OF INTENT TO ISSUE
: CERTIFICATE OF CORRECTION

This is a decision on the "REQUEST FOR RECALCULATION OF PATENT TERM ADJUSTMENT UNDER 37 C.F.R. § 1.705(d)" filed May 10, 2006. Patentees request that the patent term adjustment indicated in the patent be corrected from eight hundred and fifty-one (851) days to eight hundred and ninety-four (894) days.

The request for reconsideration of patent term adjustment is **GRANTED**.

The patent term adjustment indicated in the patent is to be corrected by issuance of a certificate of correction showing a revised patent term adjustment of eight hundred and ninety-four (894) days.

On April 4, 2006, the above-identified application matured into U.S. Patent No. 7,023,805, with a revised patent term adjustment of 851 days. The initial determination of patent term adjustment of 891 days was increased by 3 days for Office delay in issuing the patent and reduced by 43 days for the filing of an Information Disclosure Statement (IDS) after the mailing of the Notice of Allowance. On May 10, 2006, patentees timely submitted this request for reconsideration of patent term adjustment (with required fee), asserting that the correct number of days is 894 days. Patentees dispute the reduction of 43 days for filing of a "Request for Acknowledgement" of an Information Disclosure Statement (IDS) on December 1, 2005. Patentees believe it was Office error on the USPTO for recognizing this document as an IDS instead of a request for acknowledgement.

Patentees' arguments have been considered. Patentees are advised that the filing of both an IDS and a Request for Acknowledgment may be considered a failure to engage in reasonable efforts within the meaning of 1.704(c)(10). See MPEP 2732. However, in this instance, the application history has been reviewed and it is concluded that under the circumstances the filing of the request for acknowledgment of IDS should not be considered "a failure to engage in reasonable efforts" to conclude processing or examination of an application and should not result in reduction of the patent term adjustment pursuant to 37 CFR 1.704(c)(10). Patentees filed IDSs on August 28, 2001 and January 6, 2004. Accompanying the non-final Office action mailed April 6, 2005 was an initialled 1449 in response to the January 6, 2004 IDS. With respect to their earlier filed IDS, patentees made a further request for an initialled 1449 with their response filed July 6, 2005. Nonetheless, the Notice of Allowance mailed September 16, 2005 did not include an initialled 1449. In view thereof, it is concluded that the reduction of 43 days for making a request for initialled IDS after the mailing of the notice of allowance is not warranted.

In view thereof, the patent should have issued with a revised patent term adjustment of 894 days.

Receipt of the \$200.00 fee set forth in 37 CFR 1.18(e) is acknowledged. No additional fees are required.

The application file is being forwarded to the Certificates of Correction Branch for issuance of a certificate of correction in order to rectify this error. The Office will issue a certificate of correction indicating that the term of the above-identified patent is extended or adjusted by **EIGHT HUNDRED AND NINETY-FOUR (894)** days.

Telephone inquiries specific to this matter should be directed to the undersigned at (571) 272-3219.



Nancy Johnson
Senior Petitions Attorney
Office of Petitions

Enclosure: Copy of DRAFT Certificate of Correction

UNITED STATES PATENT AND TRADEMARK OFFICE
CERTIFICATE OF CORRECTION

PATENT : 7,023,805 B2

DATED : April 4, 2006

INVENTOR(S) : Tajiri et al.

DRAFT

It is certified that error appears in the above-identified patent and that said Letters Patent is hereby corrected as shown below:

On the cover page,

[*] Notice: Subject to any disclaimer, the term of this patent is extended or adjusted under 35 USC 154(b) by (851) days

Delete the phrase "by 851" and insert – by 894 days--